

ESTTA Tracking number: **ESTTA10391**

Filing date: **06/18/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Guardsmark, LLC
Granted to Date of previous extension	06/20/2004
Address	Guardsmark, LLC 22 South Second Street Memphis, TN 38103 UNITED STATES

Correspondence information	Guardsmark, LLC 22 South Second Street Memphis, TN 38103 UNITED STATES trademarkdocketing@aporter.com
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Applicant Information

Application No	78243473	Publication date	12/23/2003
Opposition Filing Date	06/18/2004	Opposition Period Ends	06/20/2004
Applicant	Nexans		

Goods/Services Affected by Opposition

Class 009. First Use: First Use In Commerce:
All goods and services in the class are opposed, namely: CABLES FOR DATA
COMMUNICATION NETWORKS

Attachments	GUARDSMARK v NEXANS.PDF (32 pages)
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Signature	/james walsh/
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Name	Guardsmark, LLC
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Date	06/18/2004
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GUARDSMARK, LLC,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Application Serial No. 78-243473
)	
NEXANS,)	Mark: GUARDSMARK
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Guardsmark, LLC, a Delaware Limited Liability Company with its principal place of business at 22 South Second Street, Memphis, Tennessee 38103 ("Guardsmark" or "Opposer"), believes that it will be damaged by registration of the mark in Application Serial No. 78-243473 and hereby opposes registration of the mark in accordance with Trademark Act § 13, 15 U.S.C. § 1063 and Trademark Rule 2.101, 37 C.F.R. § 2.101. The grounds for opposition are likelihood of confusion between the Applicant's Mark and Guardsmark's registered marks under Trademark Act § 2(d), 15 U.S.C. § 1052(d) and dilution under Trademark Act § 43(c), 15 U.S.C. § 1125(c).

I. OPPOSER'S MARK

1. Guardsmark is the owner of a series of marks consisting in whole or in principal part of the coined word GUARDSMARK used in connection with security and investigation services, as well as a wide range of other goods and services, as evidenced by U.S. Registration Nos. 2,820,390; 2,805,203; 2,309,554; 2,062,974; 2,151,195; 2,154,070; 1,986,655; 1,811,355; and 808,973 ("the GUARDSMARK Marks" or "the

GUARDSMARK Registrations”) reflected in the attached copies of the U.S. Patent & Trademark Office (“PTO”) automated (TARR) records.

2. GUARDSMARK and its predecessors have used the GUARDSMARK Marks in commerce in connection with its goods and services since at least as early as 1963 and Guardsmark continues to use the GUARDSMARK Marks in commerce.

3. Through longstanding and extensive use of the GUARDSMARK Marks, the GUARDSMARK Marks have become distinctive of Guardsmark’s goods and services in commerce and famous.

II. APPLICANT’S MARK

4. Nexans, a limited liability joint stock company of France (“Nexans” or “Applicant”), filed an application in the PTO on April 29, 2003 to register GUARDSMARK (“the Nexans Mark”), in Application Serial No. 78-243473 (“the Nexans Application”) based on its claimed intention to use that mark in commerce. The Nexans Application was published for opposition on December 23, 2003. Opposer has requested and been granted extensions of time to oppose the Nexans Application through June 20, 2004.

5. The Nexans Application identifies the goods as “cable for data communication networks” (“the Nexans goods”),

6. Nexans asserts a bona fide intent to use the mark in commerce in the Nexans Application as the only basis for registration.

III. LIKELIHOOD OF CONFUSION

7. The Nexans Mark is confusingly similar to Opposer’s GUARDSMARK Marks for the following reasons, among others:

A. Comparison of the Marks

8. Opposer's GUARDSMARK Marks include the word mark, GUARDSMARK, alone and with other wording and/or design elements. In each variation, GUARDSMARK is the only or principal distinctive element and the dominant element in the mark. "GUARDSMARK" is a coined term which is not only inherently distinctive, but unique. Opposer is not aware of any other use of GUARDSMARK as a trademark or otherwise. Opposer's GUARDSMARK Marks are entitled to a broad scope of protection because the marks are famous.

9. The Nexans Application seeks to register the GUARDMARK word mark.

10. Thus, the Nexans Mark, as identified in the Nexans Application, is legally identical to the famous marks in the GUARDSMARK Registrations in appearance, sound and overall commercial impression. The omission of the letter "s" does nothing to distinguish the marks of the parties.

B. Strength of the GUARDSMARK Mark

11. GUARDSMARK is a strong mark. GUARDSMARK is a unique, coined term which is highly distinctive and which has become famous through longstanding and widespread use.

C. Comparison of the Goods and Services

12. The parties' goods and services are related. The goods and services of Nexans and Guardsmark are offered to the same customers. Furthermore, because GUARDSMARK is a famous trademark, it is entitled to a broad scope of protection.

D. Channels of Trade

13. The Nexans Application does not include any restriction as to channels of trade or purchasers with respect to the Nexans goods. Likewise, the GUARDSMARK

Registrations do not include any restrictions as to channels of trade or purchasers. Thus, the goods and services of the parties must be presumed to move through the same channels of trade and to the same potential purchasers.

E. Priority

14. There is no issue with respect to priority. Guardsmark began use of the GUARDSMARK Marks nearly forty years before Nexans filed the intent-to-use Nexans Application.

IV. DILUTION

15. The GUARDSMARK mark is inherently distinctive and unique and the GUARDSMARK Marks have become famous through longstanding and widespread use in commerce in connection with Guardsmark's goods and services.

16. The GUARDSMARK Marks have achieved widespread recognition within the security and investigation field, in the business world in general, and among the consuming public.

17. The GUARDSMARK mark was distinctive and had become famous long before Nexans filed the Nexans Application.

18. The registration of GUARDMARK will dilute the distinctive quality of the GUARDSMARK Marks.

WHEREFORE, Opposer states that it will be damaged by registration of the mark in the Nexans Application and therefore requests that the Trademark Trial and Appeal Board ("the Board") refuse registration.

* * *

This Notice of Opposition is submitted electronically and the undersigned has authorized the payment of all official filing fees or any other fees due from Deposit Account No. 50-2387.

Opposer requests that the Board institute this proceeding and then suspend proceedings for six months to enable the parties to attempt to resolve the matter by mutual agreement.

Respectfully submitted on behalf of

GUARDSMARK, LLC.

By: 

James T. Walsh &
Roberta L. Horton
Arnold & Porter
555 Twelfth Street, N.W.
Washington, D.C. 20004-1202
(202) 942-5737

June 18, 2004

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 13:56:58 ET

Serial Number: 78045094 Assignment Information

Registration Number: 2820390 Assignment Information

Mark (words only): GUARDSMARK UNIVERSITY

Standard Character claim: No

Current Status: Registered.

Date of Status: 2004-03-02

Filing Date: 2001-01-26

Transformed into a National Application: No

Registration Date: 2004-03-02

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2004-03-08

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Guardsmark, LLC

Address:

Guardsmark, LLC
22 South Second Street
Memphis, TN 38103
United States

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

educational training services, namely, conducting seminars and classes in the field of security, investigation, security personnel and personnel management, education and training

International Class: 041

First Use Date: 2003-03-07

First Use in Commerce Date: 2003-03-07

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "UNIVERSITY"

Prior Registration Number(s):

808973
1784367
1811355
1986655
2062974
2151195
2154070
2309554

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-03-02 - Registered - Principal Register
2004-01-13 - Allowed for Registration - Principal Register (SOU accepted)
2004-01-06 - Non-final action mailed
2004-01-06 - Previous allowance count withdrawn
2003-05-23 - Allowed for Registration - Principal Register (SOU accepted)
2003-05-21 - Case file assigned to examining attorney
2003-05-20 - Statement of use processing complete
2003-03-24 - Amendment to Use filed
2003-03-26 - PAPER RECEIVED
2002-09-24 - Notice of allowance - mailed
2002-07-02 - Published for opposition
2002-06-12 - Notice of publication

2002-03-19 - Approved for Pub - Principal Register (Initial exam)

2001-12-18 - Communication received from applicant

2001-06-18 - Non-final action mailed

2001-06-13 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

James Walsh (Attorney of record)

James Walsh

ARNOLD & PORTER

555 12TH ST NW

WASHINGTON DC 20004-1200

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 13:57:38 ET

Serial Number: 76009585 Assignment Information

Registration Number: 2805203 Assignment Information

Mark (words only): GUARDSMARK SUSTAINED EXCELLENCE

Standard Character claim: No

Current Status: Registered.

Date of Status: 2004-01-13

Filing Date: 2000-03-27

Transformed into a National Application: No

Registration Date: 2004-01-13

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2004-01-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, LLC

Address:

GUARDSMARK, LLC
22 SOUTH SECOND STREET
MEMPHIS, TN 38103
United States

Legal Entity Type: Ltd Liab Co

State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

security services, namely, monitoring of security systems, fire alarms, fire fighting, security guard services, and protection services; security services, namely, civil protection services; security services, namely, inspection of

buildings, parking lots, vehicles, persons, personal belongings, fire and security alarms, systems and equipment; security services, namely, holding of items of others for safety and security reasons

International Class: 042

First Use Date: 2003-06-30

First Use in Commerce Date: 2003-06-30

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

808973
1784367
1811355
1986655
2062974
2151195
2154070
2309554

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-01-13 - Registered - Principal Register
2003-09-29 - PAPER RECEIVED
2003-11-17 - Allowed for Registration - Principal Register (SOU accepted)
2003-11-07 - Examiner's amendment mailed
2003-11-06 - Previous allowance count withdrawn
2003-09-08 - Allowed for Registration - Principal Register (SOU accepted)
2003-08-29 - Case file assigned to examining attorney
2003-08-28 - Case File in TICRS
2003-07-02 - Statement of use processing complete
2003-07-02 - Amendment to Use filed
2003-07-01 - TEAS Statement of Use Received
2003-04-03 - Extension 3 granted

2003-01-03 - Extension 3 filed
2003-01-03 - TEAS Extension Received
2002-07-08 - Extension 2 granted
2002-06-25 - Extension 2 filed
2002-06-25 - TEAS Extension Received
2002-01-17 - Extension 1 granted
2002-01-03 - Extension 1 filed
2001-07-03 - Notice of allowance - mailed
2001-04-10 - Published for opposition
2001-03-28 - Notice of publication
2000-10-20 - Approved for Pub - Principal Register (Initial exam)
2000-10-05 - Examiner's amendment mailed
2000-09-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

James T. Walsh (Attorney of record)

JAMES T. WALSH
ARNOLD & PORTER
555 12TH STREET NW
WASHINGTON, D.C. 20004

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 13:58:13 ET

Serial Number: 75167051 Assignment Information

Registration Number: 2309554 Assignment Information

Mark



(words only): G GUARDSMARK TRUTH COURAGE JUDGEMENT

Standard Character claim: No

Current Status: Registered.

Date of Status: 2000-01-18

Filing Date: 1996-09-13

Transformed into a National Application: No

Registration Date: 2000-01-18

Register: Principal

Law Office Assigned: TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2000-02-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Guardsmark, Inc.

Address:

Guardsmark, Inc.
22 South Second Street

Memphis, TN 38103

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

maintenance and repair of fire and security alarms, systems and equipment, portable radios, security and electronic equipment; cleaning services, namely, waste disposal for others; and janitorial services

International Class: 037

First Use Date: 1999-03-03

First Use in Commerce Date: 1999-03-03

Basis: 1(a)

transportation of passengers and/or goods, and/or transport services rendered by motor vehicles; traffic information services; tour guide services and messenger services

International Class: 039

First Use Date: 1999-03-03

First Use in Commerce Date: 1999-03-03

Basis: 1(a)

ADDITIONAL INFORMATION

Lining and Stippling: The stippling is a feature of the mark and does not indicate color.

Prior Registration Number(s):

808973

1811355

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2000-01-18 - Registered - Principal Register

1999-11-18 - Allowed for Registration - Principal Register (SOU accepted)

1999-10-28 - Communication received from applicant

1999-04-28 - Non-final action mailed

1999-04-26 - Case file assigned to examining attorney

1999-04-09 - Statement of use processing complete

1999-04-09 - Extension 3 granted
1999-03-09 - Amendment to Use filed
1999-03-09 - Extension 3 filed
1998-09-23 - Extension 2 granted
1998-08-28 - Extension 2 filed
1998-04-12 - Extension 1 granted
1998-03-05 - Extension 1 filed
1997-09-09 - Notice of allowance - mailed
1997-06-17 - Published for opposition
1997-05-16 - Notice of publication
1997-04-02 - Approved for Pub - Principal Register (Initial exam)
1997-03-19 - Examiner's amendment mailed
1997-03-12 - Case file assigned to examining attorney
1997-03-11 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES T WALSH (Attorney of record)

JAMES T WALSH
ARNOLD & PORTER
555 TWELFTH ST NW
WASHINGTON DC 20004-1202
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 13:58:49 ET

Serial Number: 75083165 Assignment Information

Registration Number: 2062974 Assignment Information

Mark



(words only): G GUARDSMARK TRUTH COURAGE JUDGEMENT

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2003-08-14

Filing Date: 1996-04-03

Transformed into a National Application: No

Registration Date: 1997-05-20

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-08-18

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, LLC

Address:

GUARDSMARK, LLC
22 SOUTH SECOND STREET

MEMPHIS, TN 20004

United States

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: (NOT AVAILABLE)

GOODS AND/OR SERVICES

inventory control services; receptionist services; temporary employment agency services; employment counseling services; business management consulting, investigation, and administrative services; mail sorting, handling, and receiving services; and commercial and industrial management assistance and administrative services

International Class: 035

First Use Date: 1994-01-00

First Use in Commerce Date: 1994-01-00

Basis: 1(a)

educational, instructional, and training services, namely, conducting classes and personal direct consultation, both using multimedia materials, in the area of commercial and industrial safety and emergency medical care

International Class: 041

First Use Date: 1994-01-00

First Use in Commerce Date: 1994-01-00

Basis: 1(a)

monitoring of security systems, fire alarms, and waste removal; vehicle-weighing services; security guard services; medical assistance services; health care services; emergency medical services; fire fighting and protection services; vehicle registration and inspection services; civil protection services; weather reporting services; locksmith services; security inspection services, namely, inspection of buildings, parking lots, vehicles, persons, personal belongings, fire and security alarms, systems and equipment, and storage facilities for safety, security and health hazards, fire protection, hazardous waste handling, storage and disposal, and observation and reporting of criminal activity; concierge services; and guest relation services

International Class: 042

First Use Date: 1994-01-00

First Use in Commerce Date: 1994-01-00

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "TRUTH", "COURAGE", and "JUDGEMENT"

Lining and Stippling: The lining is a feature of the mark and does not indicate color.

Prior Registration Number(s):

808973

1784367

1811355

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-08-14 - Section 8 (6-year) accepted & Section 15 acknowledged

2003-05-21 - Section 8 (6-year) and Section 15 Filed

2003-05-21 - PAPER RECEIVED

1997-05-20 - Registered - Principal Register

1997-02-25 - Published for opposition

1997-01-24 - Notice of publication

1996-11-24 - Approved for Pub - Principal Register (Initial exam)

1996-10-21 - Communication received from applicant

1996-07-26 - Examiner's amendment mailed

1996-07-16 - Non-final action mailed

1996-06-24 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES WALSH (Attorney of record)

JAMES WALSH
ARNOLD & PORTER
555 12TH STREET, NW
WASHINGTON, DC 20004

Thank you for your request. Here are the latest results from the TARR web server.

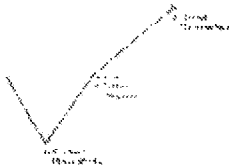
This page was generated by the TARR system on 2004-06-18 13:59:32 ET

Serial Number: 75023988 Assignment Information

Registration Number: 2151195 Assignment Information

Mark

THE GUARDSMARK PROMISE



(words only): THE GUARDSMARK PROMISE 1. CUSTOMER DISSATISFACTION 2. SERVICE RECOVERY 3. EXCEED EXPECTATIONS

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2004-05-14

Filing Date: 1995-11-27

Transformed into a National Application: No

Registration Date: 1998-04-14

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2004-05-17

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, LLC

Address:
GUARDSMARK, LLC

22 SOUTH SECOND STREET

MEMPHIS, TN 38103

United States

Legal Entity Type: Ltd Liab Co

State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

inventory control services; business management consulting services, investigation services, and administrative services

International Class: 035

First Use Date: 1996-04-05

First Use in Commerce Date: 1996-04-05

Basis: 1(a)

monitoring of security systems, fire alarms; security guard services; medical assistance services; emergency medical services; civil protection services; security inspection services, namely, inspection of buildings, parking lots, vehicles, persons, personal belongings, fire and security alarms, systems and equipment, and storage facilities for safety, security and health hazards, fire protection, hazardous waste handling, storage and disposal, and observation and reporting of criminal activity; and concierge services

International Class: 042

First Use Date: 1996-04-05

First Use in Commerce Date: 1996-04-05

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "CUSTOMER DISSATISFACTION", "SERVICE RECOVERY", and "EXCEED EXPECTATIONS"

Prior Registration Number(s):

808973

1784367

1811355

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-05-14 - Section 8 (6-year) accepted & Section 15 acknowledged

2004-04-08 - Section 8 (6-year) and Section 15 Filed

2004-04-08 - TEAS Section 8 & 15 Received

1998-04-14 - Registered - Principal Register
1998-02-02 - Allowed for Registration - Principal Register (SOU accepted)
1998-01-08 - Communication received from applicant
1997-12-02 - Communication received from applicant
1997-05-29 - Non-final action mailed
1997-05-02 - Statement of use processing complete
1997-05-02 - Extension 1 granted
1997-03-25 - Amendment to Use filed
1997-03-25 - Extension 1 filed
1997-01-14 - Notice of allowance - mailed
1996-10-22 - Published for opposition
1996-09-20 - Notice of publication
1996-08-05 - Approved for Pub - Principal Register (Initial exam)
1996-07-26 - Examiner's amendment mailed
1996-07-25 - Previous allowance count withdrawn
1996-07-03 - Approved for Pub - Principal Register (Initial exam)
1996-06-26 - Examiner's amendment mailed
1996-05-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES T WALSH (Attorney of record)

JAMES T WALSH
ARNOLD & PORTER
555 12TH ST NW
WASHINGTON DC 20004-1202

Thank you for your request. Here are the latest results from the TARR web server.

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Serial Number: 75023987 Assignment Information

Registration Number: 2154070 Assignment Information

Mark (words only): THE GUARDSMARK PROMISE

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2004-05-28

Filing Date: 1995-11-27

Transformed into a National Application: No

Registration Date: 1998-04-28

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2004-06-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, LLC

Address:

GUARDSMARK, LLC
22 SOUTH SECOND STREET
MEMPHIS, TN 38103
United States

Legal Entity Type: Ltd Liab Co

State or Country Where Organized: Not Provided

GOODS AND/OR SERVICES

inventory control services; business management consulting services, investigation services, and administrative services

International Class: 035**First Use Date:** 1996-04-05**First Use in Commerce Date:** 1996-04-05**Basis:** 1(a)

monitoring of security systems, fire alarms; security guard services; medical assistance services; emergency medical services; civil protection services; security inspection services, namely, inspection of buildings, parking lots, vehicles, persons, personal belongings, fire and security alarms, systems and equipment, and storage facilities for safety, security and health hazards, fire protection, hazardous waste handling, storage and disposal, and observation and reporting of criminal activity; and concierge services

International Class: 042**First Use Date:** 1996-04-05**First Use in Commerce Date:** 1996-04-05**Basis:** 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

808973

1784367

1811355

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-05-28 - Section 8 (6-year) accepted & Section 15 acknowledged

2004-04-09 - Section 8 (6-year) and Section 15 Filed

2004-04-09 - TEAS Section 8 & 15 Received

1998-04-28 - Registered - Principal Register

1998-03-11 - Allowed for Registration - Principal Register (SOU accepted)

1998-03-09 - Communication received from applicant

1998-03-09 - Communication received from applicant

1998-02-11 - Case file assigned to examining attorney

1998-02-09 - Statement of use processing complete

1998-01-07 - Amendment to Use filed

1997-07-25 - Extension 1 granted
1997-07-07 - Extension 1 filed
1997-01-07 - Notice of allowance - mailed
1996-10-15 - Published for opposition
1996-09-13 - Notice of publication
1996-08-05 - Approved for Pub - Principal Register (Initial exam)
1996-07-26 - Examiner's amendment mailed
1996-07-15 - Previous allowance count withdrawn
1996-07-03 - Approved for Pub - Principal Register (Initial exam)
1996-06-26 - Examiner's amendment mailed
1996-05-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES T WALSH (Attorney of record)

JAMES T WALSH
ARNOLD & PORTER
IP DOCKETING
555 12TH ST NW
WASHINGTON DC 20004

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 14:00:42 ET

Serial Number: 74608413 [Assignment Information](#)

Registration Number: 1986655 [Assignment Information](#)

Mark



(words only): GUARDSMARK WELLNESS TEAM

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2002-06-27

Filing Date: 1994-12-08

Transformed into a National Application: No

Registration Date: 1996-07-16

Register: Principal

Law Office Assigned: TMEG Law Office 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-06-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Guardsmark, Inc.

Address:

Guardsmark, Inc.
22 South Second Street

Memphis, TN 38103

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

conducting employee incentive award programs and awarding prizes and gifts to promote health, fitness, and nutrition

International Class: 035

First Use Date: 1994-12-09

First Use in Commerce Date: 1994-12-09

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "WELLNESS"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-06-27 - Section 8 (6-year) accepted & Section 15 acknowledged

2002-05-02 - Section 8 (6-year) and Section 15 Filed

1996-07-16 - Registered - Principal Register

1996-04-23 - Published for opposition

1996-03-22 - Notice of publication

1996-02-08 - Approved for Pub - Principal Register (Initial exam)

1996-02-08 - Amendment to Use approved

1996-01-29 - Amendment to use processing complete

1995-11-28 - Amendment to Use filed

1996-01-25 - Previous allowance count withdrawn

1996-01-19 - Approved for Pub - Principal Register (Initial exam)

1995-11-28 - Communication received from applicant

1995-05-30 - Non-final action mailed

1995-05-24 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES WALSH
ARNOLD & PORTER
555 TWELFTH ST, NW
WASHINGTON, DC 20004-1202
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 14:02:03 ET

Serial Number: 74272948 Assignment Information

Registration Number: 1811355 Assignment Information

Mark (words only): GUARDSMARK

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-01-13

Filing Date: 1992-05-06

Transformed into a National Application: No

Registration Date: 1993-12-14

Register: Principal

Law Office Assigned: LAW OFFICE 14

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2004-01-13

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, LLC

Address:

GUARDSMARK, LLC
22 SOUTH SECOND STREET
MEMPHIS, TN 38103
United States

Legal Entity Type: Ltd Liab Co

State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

inventory control services; receptionist services; temporary employment agency services; employment counseling services; business management consulting, investigation and administrative services; mail sorting, handling and

receiving services; commercial industrial management assistance and administrative services; and management of waste removal, janitorial and housekeeping services

International Class: 035

First Use Date: 1992-02-28

First Use in Commerce Date: 1992-02-28

Basis: 1(a)

maintenance and repair of fire and security alarms, systems and equipment, portable radios, security and electronic equipment

International Class: 037

First Use Date: 1992-02-28

First Use in Commerce Date: 1992-02-28

Basis: 1(a)

transportation of passengers and/or goods, and/or transport services rendered by motor vehicles; traffic information services; tour guide; and messenger services

International Class: 039

First Use Date: 1992-02-28

First Use in Commerce Date: 1992-02-28

Basis: 1(a)

educational, instructional and training services in the area of commercial and industrial safety and emergency medical care

International Class: 041

First Use Date: 1992-02-28

First Use in Commerce Date: 1992-02-28

Basis: 1(a)

monitoring of security systems, fire alarms, and waste removal; vehicle-weighing services; security guard services; medical assistance services; health care services; emergency medical services; fire fighting and protection services; vehicle registration and inspection services; civil protection services; weather reporting services; locksmith services; and inspection of buildings, parking lots, vehicles, persons, personal belongings, fire and security alarms, systems and equipment, and storage facilities for safety, security and health hazards, fire protection, hazardous waste handling, storage and disposal, concierge and guest relation services and criminal activity

International Class: 042

First Use Date: 1992-02-28

First Use in Commerce Date: 1992-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

808973

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-01-13 - First renewal 10 year

2004-01-13 - Section 8 (10-year) accepted/ Section 9 granted

2003-10-30 - Combined Section 8 (10-year)/Section 9 filed

2003-10-30 - TEAS Section 8 & 9 Received

2000-04-11 - Section 8 (6-year) accepted & Section 15 acknowledged

1999-12-10 - Section 8 (6-year) and Section 15 Filed

1993-12-14 - Registered - Principal Register

1993-09-21 - Allowed for Registration - Principal Register (SOU accepted)

1993-09-21 - Case file assigned to examining attorney

1993-07-26 - Statement of use processing complete

1993-06-14 - Amendment to Use filed

1993-03-02 - Notice of allowance - mailed

1992-12-08 - Published for opposition

1992-11-06 - Notice of publication

1992-09-08 - Approved for Pub - Principal Register (Initial exam)

1992-08-27 - Examiner's amendment mailed

1992-08-24 - Previous allowance count withdrawn

1992-08-12 - Approved for Pub - Principal Register (Initial exam)

1992-07-24 - Examiner's amendment mailed

1992-07-08 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

JAMES WALSH (Attorney of record)

JAMES WALSH
ARNOLD & PORTER
IP DOCKETING
555 12TH STREET, N.W.
WASHINGTON, DC 20004

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-06-18 14:03:30 ET

Serial Number: 72223122 Assignment Information

Registration Number: 808973 Assignment Information

Mark (words only): GUARDSMARK

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1986-06-25

Filing Date: 1965-07-12

Transformed into a National Application: No

Registration Date: 1966-05-24

Register: Principal

Law Office Assigned: Unknown

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-10-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. GUARDSMARK, INC.

Address:

GUARDSMARK, INC.

22 S. 2nd ST.

MEMPHIS, TN 38103

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

GUARD AND WATCHMAN SERVICES

U.S. Class: 100 (International Class 042)

First Use Date: 1963-07-00

First Use in Commerce Date: 1963-07-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1986-05-24 - Registration renewed - 20 year

1986-03-26 - Section 9 filed/check record for Section 8

CONTACT INFORMATION

Correspondent

MASON, FENWICK & LAWRENCE (Attorney of record)

MASON, FENWICK & LAWRENCE
POPHAM HAIK SCHNOBRICH & KAUFMAN
655 15TH STREET, N.W.
SUITE 800
WASHINGTON, DC 20005-5701
United States
